

Remarks

The claims were amended in accordance with the amendments above. The amendments to the claims are being made to focus the claims on those aspects of the invention which are a commercial priority of the assignee. The amendments are fully supported by the specification, claims, and figures as originally filed. No new matter is believed or intended to be involved.

Claims 74 and 14-16 were rejected under 35 USC §102(e) as being anticipated by Walker et al. (U.S. Pat. 6,754,636). Claims 17 and 73 were rejected under 35 USC §103(a) as being unpatentable over Walker et al. Claims 18-19 were rejected under 35 USC §103(a) as being unpatentable over Walker et al. in view of Reeder (U.S. Pat. 5,852,812). Claims 22-23 and 75-84 were purportedly rejected, but no statutes or prior art references were cited as a basis for such rejections. Claims 85-99 were not considered due to an election made earlier in prosecution of the present application.

Prior Art Status of Walker et al.

Applicant notes that the present specification was amended on 09/17/2003 to claim priority to U.S. Application Serial No. 09/416,333, filed 10/12/1999, as a continuation-in-part of that application. That application is a continuation-in-part of U.S. Application Serial No. 09/315,111, filed 05/18/1999, which is a continuation-in-part of U.S. Application Serial No. 09/301,102, filed 04/28/1999. Because the present application was filed before 11/29/2000, the time periods provided by 37 CFR §1.78 for making such priority claims do not apply. See 37 CFR 1.78(a)(2)(B). The amendment dated 09/17/2003 therefore properly made the present application a continuation-in-part of U.S. Application Serial No. 09/416,333, which claims priority dating as early as 04/28/1999. Accordingly, pursuant to 35 U.S.C. §120, and as set forth in MPEP 201.11, Applicant is entitled to a priority date as early as 04/28/1999. Applicant further submits that at least the presently amended independent claims are fully supported by the disclosure of U.S. Application Serial No. 09/301,102 in accordance with 35 U.S.C. §112, such that at least the presently amended independent claims are entitled to the priority date of 04/28/1999.

Walker et al. has an actual filing date of 06/22/1999. Walker et al. purports to claim priority to several applications as a continuation-in-part. However, the teachings of Walker et al. will not be entitled to a reference date that predates 06/22/1999 unless at least one of its purported parent applications provides adequate support for such teachings in accordance with 35 U.S.C. §112. MPEP 2136.03, particularly in subsection IV, makes it clear that references such as Walker et al. are not *automatically* accorded an effective reference date going back to the filing date of a purported parent application. For instance, subsection IV of MPEP 2136.03 clearly states, “In order to carry back the 35 U.S.C. 102(e) critical date of the U.S. patent reference to the filing date of a parent application, the U.S. patent reference must have a right of priority to the earlier date and the parent application must support the invention claimed as required by 35 U.S.C. 112, first paragraph.” The Office has failed to demonstrate in the record any facts, or investigation of the same, relating to the disclosures of the purported Walker et al. parent applications, particularly whether any of the purported parent applications provide support in compliance with ¶1 of 35 U.S.C. §112 for the subject matter relied upon by the Office in making the pending rejections. Thus, based on the present record, the Office has failed to support the apparent position that Walker et al. is entitled to a reference date going back any earlier than 06/22/1999. Until such findings are shown to be properly made, Applicant submits that the proper reference date for Walker et al. is 06/22/1999.

Given that the actual filing date of Walker et al. (06/22/1999) is later than the priority date that at least Applicant’s independent claims are entitled to (04/28/1999), and that no demonstration has been made in the record to show that Walker et al. is entitled to an earlier reference date, Applicant questions whether Walker et al. properly constitutes prior art relative to at least Applicant’s independent claims. Nevertheless, without waiving any rights or arguments, and without admitting any prior art status of Walker et al., Applicant will proceed to address the rejections, which rely on Walker et al. as prior art.

### §102 Rejections

Under MPEP 2131, a claim is anticipated under 35 U.S.C. §102 only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single

prior art reference. The identical invention must be shown in as complete detail as is contained in the claim. In addition, the elements in the prior art reference must be arranged as required by the claim. MPEP 2131 (emphasis added).

Applicant notes that amended independent claim 74 recites an act of “providing advertising customers the opportunity to electronically order display of advertising content at display screen locations selected by the advertising customers via an advertising customer interface.” Applicant further notes that the term “advertising customers” recited in claim 74 is intended to include, but not necessarily be limited to, the “merchants” referred to repeatedly throughout the present specification. “Advertising customers” could also include other advertisers (see, e.g., p. 13, ll. 6-25). In view of the foregoing, Applicant respectfully submits that Walker et al. fails to teach or suggest the above-quoted limitations of amended claim 74, particularly in the arrangement required by amended claim 74. The Office appears to rely heavily on Figs. 1A and 1B of Walker et al., yet Applicant submits that the such drawings fail to provide sufficient detail to properly anticipate the above-quoted limitations of amended claim 74. Ultimately, Walker et al. fails to anticipate amended claim 74 in accordance with MPEP 2131. Applicant therefore respectfully requests that the rejection be withdrawn.

### §103 Rejections

Under MPEP 2143.03, in order to establish a *prima facie* case of obviousness, the prior art reference or combination of references must teach or suggest all of the limitations of a claim. A *prima facie* case of obviousness also requires that there be some teaching, suggestion, or motivation to modify the references either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. MPEP 2143.01. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. MPEP 2143.01. *Actual evidence* of a suggestion, teaching or motivation to combine prior art references must be shown. *In re Dembiczak*, 50 USPQ2d 1614 (Fed.Cir. 1999). Broad *conclusory statements*, standing alone, simply *are not evidence*. *Id.* For at least the reasons set forth below, Applicant

respectfully submits that the combined art of record fails to render any of the present claims obvious.

Applicant submits that the art of record fails to teach or suggest all of the limitations recited in each independent claim in accordance with MPEP 2143.03. For instance, as noted above with respect to the §102 rejection, Walker et al. fails to teach or suggest all of the limitations recited in amended independent claim 74. Applicant further submits that the other references cited by the Office fail to make up for this deficiency of Walker et al. In other words, the combined art of record fails to teach or suggest all of the limitations of amended claim 74. In light of the foregoing, and in view of MPEP 2143.03, amended claim 74 is patentable over the art of record, and Applicant respectfully requests that the rejection be withdrawn.

Even if all of the references in combination taught or suggested all of the limitations recited in the amended claims, the Office has failed to establish the motivation to modify or combine the teachings of the references as required by MPEP 2143, and has instead relied upon impermissible hindsight reconstruction in declaring the claimed invention obvious. Indeed, MPEP 2143.01 admonishes that “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” (emphasis in original). Instead of being based on actual evidence as required, the motivation provided by the Office appears to be based solely on a subjective opinion of an individual examiner rendered several years after the priority date of the present application. Ultimately, there is no evidentiary basis in the record for the alleged motivation. This falls short of the standard described in MPEP 2143.01. *See In re Dembiczak*, 50 USPQ2d 1614 (Fed.Cir. 1999).

Applicant notes that the dependent claims include additional limitations not taught or suggested in the art of record, thus forming independent basis for novelty and non-obviousness.

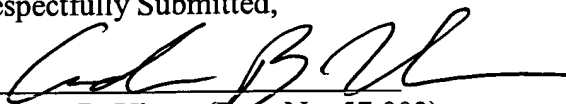
Applicant further notes that the Office Action discusses several limitations that were not recited in any of the claims pending at the time the Office Action was issued. For instance, and without limitation, the Office Action repeatedly refers to “product ordering numbers,” which

were not and are not recited in any of the claims. Applicant has no intention that such non-recited limitations be read into any of Applicant's claims, and it is not clear to Applicant why the Office has addressed claim language that is not actually present in the application. The Office Action also failed to sufficiently address several claims that were pending (and still are pending) at the time the Office Action was issued. In particular, as noted above, claims 22-23 and 75-84 were purportedly rejected, but no statutes or prior art references were cited as a basis for such rejections. Applicant respectfully requests that the next Office Action be complete as to all matters in accordance with MPEP 707.07, including citation to statutes and prior art references providing bases for any rejections by the Office.

To the extent that the present amendments constitute a narrowing of the claims, such narrowing of the claims should not be construed as an admission as to the merits of the prior rejections. Indeed, Applicant traverses the rejections and preserves all rights and arguments. While Applicant has noted several distinctions over the art of record, Applicant notes that several other distinctions exist, and Applicant preserves all rights and arguments with respect to such distinctions. To the extent that any particular statement or argument by the Office in the pending Office Action has not been explicitly addressed herein, the same should not be construed as an acquiescence or admission by the Applicant that such statements or arguments by the Office are accurate or proper.

Based on the foregoing, all pending claims are in a condition for allowance. Accordingly, Applicant respectfully requests reconsideration and an early notice of allowance. Should the Examiner wish to discuss the amendments or arguments made herein, Applicant invites the Examiner to contact the undersigned at (513) 369-4811 or via e-mail at [aulmer@fbtlaw.com](mailto:aulmer@fbtlaw.com).

Respectfully Submitted,



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